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10/031,694	01/22/2002	Friedrich Silbereisen	RAG-13902/08	8282

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EXAMINER

MACARTHUR, VICTOR L

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/031,694

Applicant(s)

SILBEREISEN ET AL.

Examiner

Victor MacArthur

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-12 and 19-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 and 19-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

Claims 22 and 28 are objected to because of the following informalities:

- The phrase "said base" (line 1 of claim 22) lacks proper antecedent basis and should be replaced with "said base body" for consistent claim terminology.
- The phrase "said second engaging edge" (lines 1-2 of claim 28) lacks proper antecedent basis and should be replaced with "a second engaging edge".

Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-12 and 19-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Wright U.S. Patent 5601262.

Claim 7. Wright discloses (fig.3) a fixing element, the fixing element (100) being connected to a support part (automobile surface, col.3, ll.15-20) by a leg (106) and having at least two engaging members (158, 164), the fixing element comprising: a guiding rail (14) connected to the leg, the guiding rail including a first side wall (132) having an engaging edge (edge of 132) and a second side wall (130), the guiding rail having at least two guiding surfaces

(surfaces of 130 and 132), one of the at least two guiding surfaces being formed on one side of the guiding rail by the second side wall and the other of the at least two guiding surfaces being formed on another side of the guiding rail by a step (140) of the first side wall, a slide (166) displaceably secured on the guiding rail, the slide having a retainer lock (118, 120) arranged on the slide and tapered in an inserting direction, the retainer lock having a retainer lock surface (126, 128) including an engaging edge (edge of 126, 128) that is positioned opposite to the engaging edge of the guiding rail, the engaging edge of the guiding rail and the engaging edge of the first side wall being directed toward one another in a mirror-inverted fashion a distance (prior to assembly) between the engaging edges being reduced (during assembly) when the slide is moved on the guiding rail in an inserting direction. The preamble recites the functional limitation "for fixing a corrugated tube to a support part". This limitation has been given only limited patentable weight. A preamble is generally not accorded much patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The Write fixing element is fully capable of performing the functional limitations "engageable with at least two undercuts provided on a corrugated tube" (line 3) and "being engageable with the at least two undercuts of a corrugated tube" (lines 15-16) thereby meeting these functional limitations of the claim. It is well established that a recitation with respect to the manner in which an apparatus is intended to be employed (*i.e.* a functional limitation) is given only limited patentable weight since it does not impose any structural limitation upon the claimed apparatus

Art Unit: 3679

which differentiates it from a prior art reference disclosing the structural limitations of the claim.

In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 136 USPQ 458 (CCPA 1963).

Claim 8. The Wright slide is positionable (but not necessarily positioned) in a disengaged position in which the slide is partially pulled out of the guiding rail and the distance between the engaging edge is the greatest, and an engaged positioning which the slide is inserted into the guiding rail and the distance between the engaging edges is reduced.

Claim 9. Wright discloses that the guiding rail further comprises a base (142) and an engaging tab (134) having an upwardly (with respect to element 112) directed locking tab (136) the locking tab being adapted to elastically engage a front notch portion (under 118) and a rear notch (between 148 and 160) provided on an underside of the slide at a distance from one another, the front notch defining the disengaged position of the slide and the rear notch defining the engaged position of the slide.

Claim 10. Wright discloses that the slide further comprises a flat base part (156), and the retainer lock includes an outer (with respect to 118) retainer lock surface (126) and an inner (with respect to 132) retainer lock surface (128), the outer retainer lock surface and the inner retainer lock surface being adapted to slidably engage the at least two guiding surfaces of the guiding rail.

Claim 11. Wright discloses that the guiding rail further comprises a first rectangular groove (124) formed underneath (when assembly is inverted) the step of the first side wall and a second rectangular groove (122) formed in the second side wall, and the slide includes a first (left side of 166) and a second guiding ridge (right side of 166) that laterally protrudes from the

Art Unit: 3679

base part of the slide, the first guiding ridge being adapted (via 128) to slidably engage the first rectangular groove and second guiding ridge being adapted (via 126) to slidably engage the second rectangular groove.

Claim 12. Wright discloses that the at least two guiding surfaces (guiding surfaces of 134 and 138) for the slide are formed on the side walls of the guiding rail and extend transversely in reference to a center line of the base of the guiding rail and the base part of the slide extends at a same angle as the guiding surfaces (in that they are parallel), and the engaging edge of the retainer lock surface and the engaging edge of the guiding rail form one guiding surface for the base part of the slide and extend parallel in reference to the center line of the base of the guiding rail.

Claim 19. Wright discloses (fig.3) a fixing element, the fixing element comprising: a slide (166) having a longitudinally extending edge (118, 120), a base body (142) having a longitudinal axis and having an engaging edge (edges of 130, 132) spaced apart (on disassembly) from the edge of the slide, the base body including a guide rail (130, 132) adapted to receive the slide for selective linear movement along the guide rail in an insertion direction parallel to the longitudinal axis of the base body, the guide rail being disposed at a predetermined angle relative to edge of the slide, such that the selective linear movement of the slide in an insertion direction causes a transverse displacement of the edge of the slide toward the engaging edge, thereby clamping the sides of a first part (C). The preamble recites the functional limitation "for fixing a first part having a pair of sides to a second part". This limitation has been given only limited patentable weight. A preamble is generally not accorded much patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of

Art Unit: 3679

the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The Wright fixing element is fully capable of performing the functional limitations "for engaging one of the pair of sides of the first part" (lines 3-4 of claim 19 and "for engaging the other of the pair of sides of the first part" (line 6 of claim 19) thereby meeting these functional limitations to the claim. It is well established that a recitation with respect to the manner in which an apparatus is intended to be employed (*i.e.* a functional limitation) is given only limited patentable weight since it does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963).

Claim 20. Wright discloses that the edge of the slide and engaging edge of the base body remain parallel during the selective linear movement of the slide relative to the base body.

Claim 21. Wright discloses that the guide rail includes a first sidewall (138) that widens in the insertion direction.

Claim 22. Wright discloses that the base body includes a second sidewall (136) that tapers in the insertion direction.

Claim 23. Wright discloses that the first and second sidewalls of the base body are spaced apart to define a transversely extending recess (between 136 and 138) for slidably receiving the slide therein.

Claim 24. Wright discloses first and second guiding surfaces (guiding surfaces of 136 and 138) extending longitudinally along the first and second sidewalls, respectively, for guiding the slide during the selective linear movement.

Claim 25. Wright discloses that the edge of the slide is defined by an undercut (where 120 meets 110) extending (during insertion) longitudinally along the first sidewall.

Claim 26. Wright discloses that the slide includes a base part (part of 166 engaged with 136 and 138 after assembly) slidably engaged with the first and second guiding surfaces.

Claim 27. Wright discloses that the slide includes a retainer lock (tapered upper portion of 164) that projects outwardly from the base part, the retainer lock tapering in the insertion direction to define an outer retainer lock surface (tapered outer surface of 164) and an inner retainer lock surface (tapered inner surface of 164) opposite the outer retainer lock surface.

Claim 28. Wright discloses that a second engaging edge (semicircular edge cut into 164) is defined by an undercut formed in the inner retainer lock surface.

Claim 29. Wright discloses that the slide is moveable in the insertion direction between a locked position (when assembled), wherein the first and second engaging edges are clampingly engaged against opposite sides of the first part, and an unlocked position (when disassembled), wherein the first and second engaging edges are disengaged from the first part.

Claim 30. Wright discloses that the base part includes a notch (where 148 meets 118) formed therein, which corresponds to the locked position.

Claim 31. Wright discloses that the base body includes an engaging tab (134) bent outwardly to engage the notch and maintain the slide in the locked position.



Art Unit: 3679

Claim 32. Wright discloses that the base body includes a leg (106) extending outwardly therefrom, the leg adapted for fixed attachment to the second part (automobile surface, col.3, ll.15-20).

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Referring to fixing elements:

Write U.S. Patent 5803414

Smith U.S. Patent 2625354

Sato U.S. Patent 5906465


Applicant's amendment (i.e. the newly added limitation "having an engaging edge and a second side wall... step of first side wall" (lines 5-9 of claim 1) and the newly added claims 19-22) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (703) 305-5701. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
VLM  
May 27, 2004



DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
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